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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,001	05/24/2000	C. Daniel McClain	ROWL-9955	4546

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Jared S Goff  
Schmeiser Olsen & Watts LLP  
18 East University Drive  
#101  
Mesa, AZ 85201

EXAMINER

WOOD, ELIZABETH D

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 11/04/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/578,001

Applicant(s)

MCCLAIN ET AL.

Examiner

Elizabeth D. Wood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-29,42,43 and 45-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-29, 42, 43 and 45-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Specification***

The examiner has not checked the specification to the extent necessary to determine the presence of **all** possible minor errors (grammatical, typographical and idiomatic). Cooperation of the applicant(s) is requested in correcting any errors of which applicant(s) may become aware of in the specification, in the claims and in any future amendment(s) that applicant(s) may file.

Applicant(s) is also requested to complete the status of any copending applications referred to in the specification by their Attorney Docket Number or Application Serial Number, **if any**.

The status of the parent application(s) and/or any other application(s) cross-referenced to this application, **if any**, should be updated in a timely manner.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 5-29, 42, 43 and 45-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims as amended are replete with grammatical and idiomatic errors that make it impossible to determine exactly what applicant is trying to claim. As an example, claim 5 makes no sense. There is significant redundant and extraneous language. If applicant is trying to say that the first aqueous composition consists of a pigment composition, then the claim should be so drafted. Another example is claim 6. If applicant is trying to say that the pigment composition of claim 5 is titanium dioxide, then the claim should be so drafted. Claim 7 recites "in the receiving reservoir which has been premixed". This is clearly confusing context. The remaining claims all have the same problems and should be very carefully revised.

Claims 1, 17, 20, 42, 45 and 54 are indefinite in the language "selected from a group consisting". Claim 54 recites "consisting of a". Proper Markush terminology is "selected from the groups consisting". These claims are further indefinite in the language "the second aqueous composition selected from the group of premixed aqueous compositions" and the language "the third aqueous composition selected from the group of premixed aqueous compositions" and the language "the second aqueous composition selected from the group of premixed aqueous compositions". No Markush group is provided. The examiner has examined the claims as though the members of the Markush group are the same as those for the "first aqueous composition", but the claims must so specify.

Claim 2 does not appear to limit the method of claim one as claim 1 already recites "mixing the first composition with the second and third compositions".

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Claim 50 recites the unclear language "using the desired paint characteristics". Using how? This is not an active and specific method step and the metes and bounds of the claims are therefore unclear. Claim 51 has the same problem. It attempts to limit the manner in which characteristics are "predetermined", but simply recites "using the desired characteristics". It presents no active specific method steps, the metes and bounds of the claim are unclear and it does not appear to limit claim 50 because it does not appear to add any specific step to the method.

Claims 42-52 are indefinite in the terminology "predetermined" and "desired" as these terms are undefined and relative and therefore cast doubt on the scope of the coverage being sought. For example, it is unclear and undefined as to how one would determine a predetermined amount or determine by calculating a predetermined amount using desired paint characteristics.

Claims 52-54 remain indefinite in that they are incomplete. It is unclear how a paint composition is obtained absent agitation of the precursor components. Applicant asserts that agitation would be part of the claimed step of "producing the desired paint composition". This is incorrect. The examiner cannot read such limitations into the claims. Applicant's claim 54 actually provides limitations on the meaning of "automatically producing the desired paint composition" and if applicant's reasoning is correct, then the examiner should have already read these limitations into claim 52.

***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 42, 43 and 45-54 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kim or Hoekstra et al. for the reasons set forth in the previous office action.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 5-29, 42, 43 and 45-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al. for the reasons set forth in the previous office action.

***Response to Arguments***

Applicant's arguments filed September 23, 2002 have been fully considered but they are not persuasive.

Regarding the rejections under 35 USC 102, Applicant appears to be arguing that the primary difference between the instant claims and the reference disclosures is that the instant invention involves "actually mixing the paint itself" rather than simply tinting. The examiner, however, fails to see the significance associated with this argument. Such limitation is not in the claims and would be accorded little weight even if it was present. Applicant also seems to attach some importance to on-site production of the paint, rather than factory manufacture. Again the examiner fails to see the significance of this argument because it is not in the claims and would be accorded little weight if it was present. The factory production itself of paint would clearly read on the instant claims because there is nothing in the claims to distinguish them therefrom. In fact, this argument would appear to be an admission that the only difference between conventional paint making and the instant claims is the location where the process takes place. Clearly this is not a patentable distinction. Finally, the claims still read directly on the mixing of several commercially available components for a known purpose in a known manner.

Regarding applicants' statements that the particular components are "completely unknown in the art". This makes no sense to the examiner because they are known in the art and commercially available additives to paints as admitted in the instant specification. This is the reason why the examiner made the statement regarding the

conventionality of the components in the previous office action. Applicant's reference to their specification also points out that these are commercially available to paint manufacturers, which supports the examiner's position.

Finally, the instant claims still read directly on the mixing process at a Home Depot because when selecting the particular color and finish several different pigments and tints may need to be provided and applicant's claim does not preclude several pigments, it precludes identical pigments. Applicant argues that claim 42 does have this limitation, however, the examiner considers that "a different one" does not mean from a different Markush group, it simply means a different substance. Furthermore, as these substances are known components of paint compositions and commercially available as such, it is not seen how the selection of known paint components and the mixing thereof to produce paint can be considered a non-obvious invention.

Regarding limitations in the dependent claims such as "recalibrating a scale", it is pointed out that anyone operating machinery would know the importance of being certain that it functions properly. However, because this is an apparatus limitation it is given no weight in a process claim.

Limitations such as "determining amounts required" are considered to be inherent to the prior art processes.

Applicant should also note that claims 52-54 do not even contain the mixing limitations, they simply recite a method of producing paint by operating exactly the type



of apparatus as found at Home Depot. The above-addressed arguments are not even relevant to these claims.

Regarding the rejections over 35 USC 103, all of the above arguments are equally applicable. The following comments are also pertinent.

Limitations such as adding a fourth component do not impart patentability to an otherwise unpatentable process.

Clearly the addition of an additional known prior art component to effect results that are expected to the skilled artisan is within the purview of 35 USC 103. In re Skoner 186 USPQ 80.

### ***Double Patenting***

The previous rejection of claims 1, 2 and 5-28 under the judicially created doctrine of obviousness-type double patenting is withdrawn in view of the terminal disclaimer filed September 23, 2002.

### ***Conclusion***

Applicant is advised that any evidence to be provided under 37 CFR 1.131 or 1.132 and any amendments to the claims and specification should be submitted prior to final rejection to be considered timely. It is anticipated that the next office action will be a final rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth D. Wood whose telephone number is 703-308-3802. The examiner can normally be reached on M-F, 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Elizabeth D. Wood  
Primary Examiner  
Art Unit 1755

edw  
November 1, 2002